

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
CERTIFICATE UNDER 37 C.F.R. §1.8

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/Michelle Ludwig/

Michelle Ludwig

February 5, 2009

Date

In re application of: Baum et al.

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Serial No.: 10/563,270

) Examiner: Kubelik

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Filed: January 4, 2006

) Group Art Unit: 1638

)

371 Acceptance Date: May 2, 2006

)

) Conf. No. 4307

For: Insecticidal Proteins Secreted from

)

Bacillus Thuringiensis and Uses Therefor

)

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Corrected Reply to Request for Information under 37 CFR 1.105

This Corrected Reply is being filed to correct the following inadvertent errors in the first submission. The Certificate of Service on the Transmittal and the Reply inadvertently listed the filing date as January 4, 2008 and it should have been February 4, 2009. The second correction was the missing signature on the Certification Statement attached to the PTO/SB/08a. Both of these errors have been corrected and the Corrected Reply is being resubmitted for consideration.

This paper is filed in reply to the Examiner's request for information under 37 CFR 1.105 in the above captioned matter which request was mailed on August 5, 2008 and specified no time for reply. According to 37 CFR 1.134 entitled Time Period for Reply to an Office Action, since no time limit was specified for reply to the Examiner's request, it is believed that the provisions of 37 CFR 1.134 second sentence are applicable. Since the Applicant was not notified in writing that a reply is required in less than six months, a maximum of six months is believed to be allowed in this particular matter and it is further believed that there is no fee or extension of time required in this case. However, if the Office deems otherwise, the Office is herewith authorized to deduct any underpayment from or refund any overpayment to the Applicant Monsanto Company's USPTO Deposit Account No. 13-4125. In view of the remarks below, it is believed that this response is timely filed and fully satisfies the Applicant's obligations under 37 CFR 1.105.

The Examiner has specified in the Request for Information that the Applicant is claiming a nucleic acid that hybridizes to a nucleic acid isolated from *Bacillus thuringiensis* strain 86883. The Applicant respectfully disagrees with the Examiner's position in this matter. The only original claim that encompassed this subject matter in the way that the Examiner is now suggesting was original claim 13, which was cancelled with the Applicant's response on May 7 2008 via EFS WEB to a Notice of Non-Compliant Amendment which was mailed from the USPTO on April 14, 2008. Since this subject matter is no longer a part of the claimed subject matter, and since the Examiner's request for information about the subject matter which is not longer within the scope of the claims was acted on by the Examiner after the date the claims were amended to remove this subject matter, it is believed that the request is now moot and furthermore improper. Because the subject matter is no longer a part of the claimed subject matter, the requested information is no longer necessary for the Examiner to make a meaningful and complete search of the prior art.

Nevertheless, the Applicant herewith provides answers to each of the Examiners' interrogatories (i) and (ii):

**Interrogatory No. (i):**

What are the sources of the *B. thuringiensis* strains in which TIC protein 1201 is present? Please supply all of the designations/denominations used for these strains.

**Answer to Interrogatory No. (i):**

Each of the strains was provided to Monsanto Company in library of *Bacillus thuringiensis* strains upon the January 6, 1996 purchase of Bt technology from a company referred to at that time as Ecogen Inc. The designations/denominations used for these strains as used in the specification is no different than that used by Ecogen upon transfer to Monsanto Company, and subject to the remarks below, no other names are known for each of these strains.

The strains at reference in the original Claim 13 correspond to EG2158, EG6489, EG6561, EG3618, EG6555, EG6618, EG4653, and 86833. Other strains in the application are referenced, and to the extent any information is known about source, other than from the Ecogen Bt library referenced above, or otherwise, it is disclosed herein. Absent any disclosure herein, no other information is available.

EG2158 was originally disclosed in a publication by Donovan et al., (1988) Mol. Gen. Genet. 214:365-372. No other strain designation was provided in that document. The strain was not made publicly available and no knowledge is had by the Applicant with reference to which is submitted along with this paper in supplemental IDS.

EG4332 and EG5858 were first disclosed in US Patent Application 11/194,345, filed August 1, 2005, and of course the inquiring Examiner is responsible for this particular '345 applications' progress in prosecution before the USPTO. The only other strain designations that are known for these strains corresponds to NRRL strain repository numbers, respectively NRRL B-30759 and B30760, deposited with the NRRL on July 30, 2004.

Strain 86833 was obtained by an Ecogen employee upon purchase from a Chinese Culture Collection, and no other designation is known for this particular strain.

No other designation is known for the other strains in the original claim 13 or otherwise referenced in the specification, and no other information is available with respect to each of the strains' origin or source.

**Interrogatory No. (ii):**

At or before the time of filing of the instant application or any provisional application to which benefit is claimed, had said *B. thuringiensis* strains been disclosed or made publicly available? If so, under what designation/denomination and under what conditions were said strains disclosed or made publicly available and from when to when?

**Answer to Interrogatory No. (ii):**

The answer for interrogatory is believed to be stated in the answer to Interrogatory No. (i).

It is respectfully requested that the Examiner enter the answers to the Interrogatories and proceed with examination of the claims on the merits.

Respectfully submitted,

/ Timothy K. Ball/

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